# UNITED STATES PATENT AND TRADEMARK OFFICE

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/049,982 | 08/07/2002 | Gerd Reger | 2322.66244 | 2669 |

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| 24978 7590 03/22/2007 | | EXAMINER | |
| GREER, BURNS & CRAIN | | AUSTIN, SHELTON W | |
| 300 S WACKER DR | | | |
| 25TH FLOOR | | ART UNIT | PAPER NUMBER |
| CHICAGO, IL 60606 | | 2623 | |

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

| | Application No. | Applicant(s) |
|---|---|---|
| **Office Action Summary** | 10/049,982 | REGER ET AL. |
| | Examiner | Art Unit | |
| | Shelton Austin | 2609 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on _07 August 2002_.

2a)☐ This action is **FINAL**.     2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) _18-40_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _18-40_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All   b)☐ Some * c)☐ None of:

      1.☒ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _11/21/2002_.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

## DETAILED ACTION

### *Drawings*

1.     Applicant is required to furnish a drawing to facilitate understanding of the

invention under 37 CFR 1.81(c).  No new matter may be introduced in the required

drawing.  Each drawing sheet submitted after the filing date of an application must be

labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37

CFR 1.121(d).

### *Specification*

The following guidelines illustrate the preferred layout for the specification of a
utility application.  These guidelines are suggested for the applicant's use.

#### Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should
include the following sections in order.  Each of the lettered items should appear in
upper case, without underlining or bold type, as a section heading.  If no text follows the
section heading, the phrase "Not Applicable" should follow the section heading:

(a) TITLE OF THE INVENTION.
(b) CROSS-REFERENCE TO RELATED APPLICATIONS.
(c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR
        DEVELOPMENT.
(d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT.
(e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A
        COMPACT DISC.
(f) BACKGROUND OF THE INVENTION.
        (1) Field of the Invention.
        (2) Description of Related Art including information disclosed under 37
        CFR 1.97 and 1.98.
(g) BRIEF SUMMARY OF THE INVENTION.
(h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
(i) DETAILED DESCRIPTION OF THE INVENTION.
(j) CLAIM OR CLAIMS (commencing on a separate sheet).
(k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
(l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825.  A
        "Sequence Listing" is required on paper if the application discloses a

nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

## *Claim Objections*

2.    Claim 18 is objected to because of the following informalities: "The method for" in the first line of claim 1 should be "A method for". Appropriate correction is required.

3.    Claim 20 is objected to because of the following informalities: "outputted" should be replaced with "output". Appropriate correction is required.

4.    Claim 24 is objected to because of the following informalities: Claim 24 recites "and the at least single storage" in line 11. This statement lacks antecedent basis and should read "and an at least single storage." Appropriate correction is required.

## *Claim Rejections - 35 USC § 112*

5.    The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6.    Claims 18, 22, 26, 28, 31, 32, 34-37 and 40 are rejected as failing to define the invention in the manner required by 35 U.S.C. 112, second paragraph.

In regards to claims 18, 22, 26, 28, 31, 32, 34-37 and 40, the phrases "preferably" and "especially preferably" render the claims indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

## *Claim Rejections - 35 USC § 103*

7.    The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in

section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

such that the subject matter as a whole would have been obvious at the time the invention was made to a

person having ordinary skill in the art to which said subject matter pertains.  Patentability shall not be negatived

by the manner in which the invention was made.

8.    Claims 18-34 and 36-40 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Reilly et al. (US 5,740,549) in view of Donahue et al. (US 6,101,180).

Claims 18 and 38 is rejected, in view of the 112, 2$^{nd}$ paragraph rejection above,

as best as can be understood by the examiner.  Reilly et al. (Reilly) teaches a method

and corresponding system for controlling an interactive or bi-directional communication

system, preferably for controlling the supply of information in interactive communication

systems, wherein at least one first communication terminal (Fig. 1—102; col. 4, lines 1-

5—client computer or subscribers' computers) and at least one second communication

terminal (Fig. 1—104; col. 4, lines 1-5—information server computer) are connected

through an internet connection (Fig. 1—119—internet interconnectivity, switches, etc.)

which is independent of said communication terminals, and at least one direct

connection between at least one first communication terminal and at least one second

communication terminal is automatically established, maintained, mediated or

interrupted by the station (col. 4, lines 8-10; col. 6, lines 26-31), whereby the number of

connections or the duration of the connection is controlled by predefined criteria (col. 7,

lines 60-64; col. 8, lines 19-30). Reilly fails, however, to teach that the first and second communications terminals are registered with at least one switch station, which is independent of the terminals.

In analogous art, Donahue et al. teaches a router (Fig. 2—P13) at that connects hosts to customers. The router receives an input packet of information, examines its source and destination address (registered with the router), and determines the optimal output port for the information (Fig. 2; col. 7, lines 6-11).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of Reilly to include a router between the first and second communication terminals in order have the functionality to determine the next path of the information being transmitted based on the source and destination addresses. Through the router, customers could connect to the hosts through different Internet domains (col. 7, lines 44-47).

In regards to claim 19, Reilly teaches the method according to claim 18, wherein an arbitrary number of direct connections between at least one communication terminal and at least one second communication terminal are established, maintained, mediated or interrupted simultaneously or successively (col. 8, lines 19-24).

In regards to claim 20, Reilly teaches the method according to claim 18, wherein data, which are not actively selected by the users, are transmitted, processed, output or accessed (col. 15, lines 4-6), whereby

the number of transmissions, processings, outputs or accesses are controlled by

predefined criteria (col. 7, lines 60-64; col. 8, lines 19-24),

and the duration of the transmission, the processing, the output or the access is

controlled by predefined criteria (col. 8, lines 24-30).

In regards to claim 21, Reilly teaches the method according to claim 20, wherein

the predefined criteria are arbitrarily definable, preferably the predefined criteria are

selected from a group containing a duration of data, an amount of data and a kind of

data (col. 14, lines 62-67).

Claim 22 is rejected, in view of the 112, $2^{nd}$ paragraph rejection above, as best as

can be understood by the examiner. Reilly teaches the method according to claim 20,

wherein

the number of connections, data accesses, data transmissions, data processings

or data outputs is arbitrary (col. 8, lines 19-22), preferably 1 to 100, more preferably 1 to

25, especially preferably 1 to 10, and

the duration of the transmission, the access, the processing or the output is up to

120 minutes, preferably 1 microsecond to 10 minutes, more preferably 0.1 seconds to

60 seconds, especially preferably 1 second to 30 seconds (col. 8, lines 36-44).

In regards to claim 23, Reilly teaches the method according to claim 18, wherein

the first communication terminal (col. 6, lines 46-49 & 57-61—acting as data source; col.

2, line 67-col. 3, line 5—acting as data receiver) and the second communication

terminal (col. 2, line 67-col. 3, line 5—acting as data source; col. 4, lines 28-30—acting

as data receiver) act as data sources and data receivers at the same time.

In regards to claim 24, Reilly teaches the method according to claim 20, wherein

on occurrence of a predefined first operating state (a) of at least one first

communication terminal, a second operating state (b) is established, whereby

said second operating state (b) is the at least single establishment or

maintenance of a communication connection between said first communication terminal

and a second communication terminal acting as a data source and the at least single

transmission of external data, which has not actively been selected by the user, and the

at least single storage, processing or outputting of said external data by/at the first

communication terminal for a predefined or arbitrarily definable period of time, whereby

said communication connection is newly established, and the transmission, storage,

processing or output is established newly, instead of or additionally to an existing

transmission, storage, processing or output (col. 7; lines 60-64; col. 8, lines 19-44).

In regards to claim 25, Reilly teaches the method according to claim 24, wherein

on occurrence of a predefined third operating state (c) after the previously occurred

second operating state (b), a fourth operating state (d) is established (col. 12, lines 57-

61—after updated information is provided to the client, a screen saver displaying news

items and advertisements is interrupted upon detection of user input).

Claim 26 is rejected, in view of the 112, 2$^{nd}$ paragraph rejection above, as best as

can be understood by the examiner. Reilly teaches the method according to claim 24,

wherein the first operating state (a) is a predefined use of the first communication

terminal or a part of the first communication terminal at a predefined time or for a

predefined period of time, or a predefined decreasing, non-, fewly or less varying use or

an interruption of the use at a predefined time or for a predefined period of time,

preferably the decrease, the decrease in variation or the interruption of the reception,

the transmission or the output of external data or their representations perceptible by

the human senses via an existing connection of the first communication terminal to an

external data source or a further communication terminal, preferably the decrease, the

decrease in variation or the interruption of an input procedure, a processing procedure,

a storing procedure or an output procedure at/of the first communication terminal,

especially preferably the decrease, the decrease in variation or the interruption of an

action or interaction of the user with/at the first communication terminal (col. 8, lines 41-

44—when the user's computer has not received any user input for a minimum period of

time).

In regards to claim 27, Reilly teaches the method according to claim 24, wherein

the first operating state (a) is a user interactions or a decreasing, non- or less varying or

an interrupted user interaction with the first communication terminal at a predefined time

or for a predefined period of time via remote control, keyboard, mouse, joystick, pen,

trackball, patchfield, touchscreen, audiovisual recording or reproduction media or

interfaces therefore (col. 8, lines 41-44—when the user's computer has not received

any user input for a minimum period of time; col. 11, lines 43-46—examples of user

input, e.g. keyboard or pointer device).

Claim 28 is rejected, in view of the 112, 2<sup>nd</sup> paragraph rejection above, as best as
can be understood by the examiner. Reilly teaches the method according to claim 25,
wherein (c) is a predefined use interruption, use or a reuse of the first communication
terminal or a part of the first communication terminal at a predefined time or for a
predefined period of time, an increase of use or an increasingly varying use, preferably
of the reception, the transmission or the output of external data or their representations
perceptible by the human sense organs via an existing connection of the first
communication terminal to an external data source or a further communication terminal
or the establishment of such a connection at a predefined time or for a predefined
period of time, preferably of an input-, processing-, storage- or output procedure of the
communication terminal, especially preferably of an action or interaction of the user
with/at the first communication terminal (col. 12, lines 60-61—user input).

In regards to claim 29, Reilly teaches the method according to claim 25, wherein
the third operating state (c) is a user interaction or an increasing, increasingly varying
user interaction with the first communication terminal at a predefined time or for a
predefined period of time via remote control keyboard, mouse, joystick, pen, track ball,
patch field, touch screen, audio/visual recording or reproduction media or interfaces
therefore (col. 12, lines 60-66).

In regards to claim 30, Reilly teaches the method according to claim 25, wherein
the third operating state (c) is also a first operating state (a) or a second operating state
(b) depending on a predefined time or period of time or a predefined kind, composition

or amount of the transmitted, processed, stored or output external data or their

representations perceptible by human sense organs (col. 11, lines 43-52—lack of user

input, first and third operating state, at the client computer causes connection to the

information server, second operating state, and also causes a screen saver, fourth

operating state).

Claim 31 is rejected, in view of the 112, 2nd paragraph rejection above, as best as

can be understood by the examiner. Reilly teaches the method according to claim 25,

wherein the fourth operating state (d) is the termination or interruption of the second

operating state (b) for a predefined period of time, preferably the termination or

interruption of the communication connection between the communication terminal and

an external data source or the termination or interruption of the transmission, storage,

processing or output of the external data at/by the first communication terminal,

preferably the change to or the new establishment of a communication connection

which existed before the occurrence of the first operating state (a), the change to a

predefined further communication connection, the change to the operating state before

the occurrence of the first operating state (a), the change to a predefined further

operating state or a predefined action of the first communication terminal or interaction

with further communication terminals or external data sources (col. 7, lines 60-64; col. 8,

lines 19-35). It is inherent that upon completion of the "administrative update" and

"news story update" (third operating state) the connection between the information

server and the client computer will be terminated  (fourth operating state). This is

evidenced by the fact that the inventor uses the term "update connection" which implies

that the connection is for updating the database only, therefor, when the update is complete the connection will terminate.

Claim 32 is rejected, in view of the 112, 2nd paragraph rejection above, as best as can be understood by the examiner. Reilly teaches the method according to claim 25, wherein the first operating state (a), the operating state before the occurrence of the first operating state (a), the second operating state (b), the third operating state (c) or the fourth operating state (d) or the times, periods of time, the kinds, compositions or amounts of data related to them, are automatically recorded, recognized, measured, processed, stored stationarily or non-stationarily or transmitted to one or several members of the communication system , preferably to external data sources or providers of the communication system (col. 7, lines 60-64—information from the information server is transmitted to, and stored in, the database of the client computer).

In regards to claim 33, Reilly teaches the method according to claim 32, wherein the recorded, recognized, measured, processed, the stored or transmitted data are protected against an intrusion or access by the user (col. 7, lines 51-54—user has to be a registered user in order to gain access to transmitted data).

Claim 34 is rejected, in view of the 112, 2nd paragraph rejection above, as best as can be understood by the examiner. Reilly teaches the method according to claim 25, wherein predefined or arbitrarily definable units or control codes are formed or assigned by a qualification, quantification, categorization or weighting of the operating states (a), (b), (c) or (d) or the times, periods of time, the kinds, compositions or amounts of data

related to them or by predefined external data, preferably data retrieved by the user

(col. 5, lines 24-33).

Claim 36 is rejected, in view of the 112, $2^{nd}$ paragraph rejection above, as best as

can be understood by the examiner. Reilly teaches the method according to claim 34,

wherein the actual units or control codes or the actions or values.controlled by them, or

the units or control codes or the actions or values controlled by them, that are retrieved

during a predetermined period of time are output at the first communication terminal, or

are changed by a predefined use of the first communication terminal, or are stored

stationarily or non-stationarily or are transmitted to one or several members of the

communication systems, preferably to a second communication terminal in the

communication system or to providers of the communication system (col. 5, lines 24-

34—display scripts are sent from information server to client computer and stored in the

information database).

Claim 37 is rejected, in view of the 112, $2^{nd}$ paragraph rejection above, as best as

can be understood by the examiner. Reilly teaches the method according to claim 20,

wherein the kind of output, the output frequency or intensity of the transmitted external

data or their representations at the first communication terminal are predefined,

automatically recognized, processed, stored stationarily or non- stationarily, protected

against user access or intrusion or transmitted to one or several members of the

communication system, preferably to second communication terminals or providers of

the communication system (col. 7, lines 60-64—information from the information server

is transmitted to, and stored in, the database of the client computer).

In regards to claim 39, Reilly teaches the communication system according to

claim 38, wherein the communication system comprises at least one system that is

selected from a group including a telecommunication system, a telephone system, a

facsimile system, a radio system, a radio data system, a mobile phone, an interactive

TV system, a pay-TV system, a pay-per-view system, a video- on-demand system, an

interactive video system, a computer network, an intranet, an extranet, a multimedia

network and the Internet (col. 1, lines 4-10).

In regards to claim 40, Reilly teaches the communication system according to

claim 38, wherein the first communication terminal is a data receiver, preferably a

telephone, mobile phone, PC or a client module (Fig. 1—102; col. 4, lines 1-5—client

computer or subscribers' computers), and the second communication terminal is a data

source, preferably a content-provider server, especially preferably an adserver or an

adpage (Fig. 1—104; col. 4, lines 1-5—information server computer).

9.      Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Reilly et

al. in view of Donahue et al., and further in view of Ginter et al. (US 5,892,900).

Claim 35 is rejected, in view of the 112, $2^{nd}$ paragraph rejection above, as best as

can be understood by the examiner.  Reilly teaches the method according to claim 34,

wherein the control codes, units or predefined combinations of said units and control

codes are used to automatically control or account at least one of the operating states

(a), (b), (c) or (d); the time and/or period of time related to it; the kind, composition

and/or amount of the external data (col. 5, lines 24-33). Reilly, however, fails to teach

the control codes, units or predefined combinations of said units and control codes are

used to automatically control or account the amount and/or kind of possible fees for the

user, fee reductions, omitted fees, credited fees, refunded fees and/or equivalents

preferably cash benefits, payments in kind and/or services; the amount and/or kind of

possible fees and/or equivalents for third parties, preferably suppliers and/or initiators of

the transmitted external data.

In analogous art, Ginter et al. teaches a distribution environment that allows

distributors of electronic information to reliably bill for, and securely control, audit and

budget the use of electronic information. The usage control information provides for

usage billing and usage payment (Figs. 3 & 4; col. 3, lines 18-45; col. col. 58, line 22-

col. 59, line 6).

It would have been obvious to one having ordinary skill in the art at the time the

invention was made to modify the invention of Reilly to include in the control codes the

ability to control the amount and/or kind of possible fees for the user, fee reductions,

omitted fees, credited fees, refunded fees and/or equivalents preferably cash benefits,

payments in kind and/or services; the amount and/or kind of possible fees and/or

equivalents for third parties, preferably suppliers and/or initiators of the transmitted

external data in order to regulate the use of such content and consequences of such

use (col. 1, lines 21-24).

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shelton Austin whose telephone number is (571) 272-9385. The examiner can normally be reached on Monday through Thursday from 7:30-5:00. The examiner can also be reached on alternate Fridays from 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Grant whose telephone number is (571) 272-7294, can be reached on Monday through Thursday from 7:30-5:00. The supervisor can also be reached on alternate Fridays from 7:30-4:00. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Shelton Austin

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